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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,919	07/10/2000	Emil Breeding	PM 271581	9519

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EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2622

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,919

Applicant(s)

BREDING ET AL.

Examiner

CHAN S PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are previously objected by the Draftsperson under 37 CFR 1.84 and the Applicant fails to provide replaced/corrected drawings. Appropriate corrections are required.

Response to Amendment

2. Applicant's amendment was received on 4/6/04, and has been entered and made of record. Currently, **claims 1-12** are pending.

Response to Arguments

3. Applicant's arguments, see pages 6-12, filed 4/6/04, with respect to claims 1-12 have been fully considered and are persuasive. The rejection of claims 1-12 has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Hansen U.S. Patent No. 6,509,974 and Brooke et al. U.S. Patent No. 6,748,569 (hereinafter Brooke)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen in view of Brooke.

4. With respect to claim 1, Hansen discloses a method of allowing a customer to a printing service provider to create a PDF document through a computerized interface and send the PDF document to the service provider through a network for data-communication, whereby the service provider directs the PDF document to a suitable printing office through a network for data-communication, comprising:

a PDF engine generating a customer (user) PDF document using XML files (col. 15, lines 29-38; col. 17, lines 10-31 & fig. 4); wherein

XML files are embedded in PDF (unused portion of printer format code) to describe how said data is to be positioned and formatted (mobile page featured in col. 17, lines 10-31), in a created document by the customer through said interface;

wherein said PDF document generating comprises analyzing the XML files, merging data, and formatting information (col. 17, lines 10-31);

wherein the PDF document generated using the XML files is generated at the site of the customer (desktop 302 & 306 in fig. 4); and

wherein the data for printing (document) and the design (page feature) of the PDF document differ (col. 17, lines 22-23).

As noted above, Hansen discloses a method of embedding XML files to PDF document. However, Hansen does not explicitly disclose that the XML files are comprised of a first and second XML files.

Brooke, on the other hand, discloses a method of generating a print document using two XML files wherein the first XML file (XML meta-document sheet) comprises data and its data type for printing which is created by a customer through an interface and the second XML file (style sheet) comprises a description of how said data is to be positioned and formatted, in a created document by the customer through said interface (col. 12, lines 17-67).

Although the invention is used in web page document design throughout the description of the invention, it is noted that the invention is not only limited to the web page document design but it is also applicable to other networks, such as a printing network, that utilize documents with content represented in a markup language (col. 2, lines 63-67 & col. 3, line 65 – col. 4, line 7). Further, it is well known to one of ordinary skill in the art that documents displayed in the web can well be printed by the printer as Brooke disclosed in the invention.

Hansen and Brooke are analogous art because they are from the same field of endeavor that is creating documents in XML.

Since Hansen discloses that a PDF document using XML files can be applied in the printing environment, it would have been obvious to a person of ordinary skill in the

Art Unit: 2622

art at the time of invention to combine the method of using two XML files of Brooke with the method of printing PDF document using XML files of Hansen.

The suggestion/motivation for doing so would have been to allow a user to customize selected portions of the output document while using shared content and style for the remaining portions of the output document (col. 3, lines 35-37 of Brooke).

Therefore, it would have been obvious to combine Brooke with Hansen to obtain the invention as specified in claim 1.

5. With respect to claim 2, Hansen discloses a method according to claim 1, wherein high-resolution images, fonts, and color definitions are embedded in the PDF document (col. 10, lines 22-26 & col. 17, lines 56-59).

6. With respect to claim 3, Hansen discloses a method according to claim 1, wherein an arbitrary printing office for online printing is provided (col. 3, lines 20-33).

7. With respect to claim 4, Brooke discloses a method according to claim 1, wherein the second XML file describes a layout of the whole document (col. 6, lines 10-15).

8. With respect to claim 5, Brooke discloses a method according to claim 1, wherein a questionnaire based on non-static text elements in the second XML file is created (col. 11, lines 8-27).

9. With respect to claim 5, Hansen discloses a method according to claim 1, wherein a questionnaire (job ticket or ticket) based on non-static text elements in the file (col. 3, line 56 – col. 4, line 11).

Art Unit: 2622

10. With respect to claim 6, Brooke discloses a method according to claim 1, wherein every non-static text element in the second XML file has a reference to data in the first XML file (col. 11, lines 19-27).

11. With respect to claim 7, arguments analogous to those presented for claim 1, are applicable. The examiner interpreted "a method" as a "a system"

12. With respect to claim 8, arguments analogous to those presented for claim 2, are applicable.

13. With respect to claim 9, arguments analogous to those presented for claim 3, are applicable.

14. With respect to claim 10, arguments analogous to those presented for claim 4, are applicable.

15. With respect to claim 11, arguments analogous to those presented for claim 5, are applicable.

16. With respect to claim 12, arguments analogous to those presented for claim 6, are applicable.

Art Unit: 2622

Conclusion


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
June 23, 2004


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